

**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address : COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/686,210	04/16/91	BERNAUER	K 8465
			EXAMINER
			REAMER, J
GEORGE M. GOULD 340 KINGSLAND ST. NUTLEY, NJ 07110			6
			ART UNIT
			PAPER NUMBER

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

1206  
DATE MAILED: 10/23/91

☒ This application has been examined ☒ Responsive to communication filed on 7/1/91 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I - THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1. ☐ Notice of References Cited by Examiner, PTO-892. 2. ☐ Notice re Patent Drawing, PTO-948.  
3. ☒ Notice of Art Cited by Applicant, PTO-1449. 4. ☐ Notice of Informal Patent Application, Form PTO-152  
5. ☐ Information on How to Effect Drawing Changes, PTO-1474. 6. ☐ \_\_\_\_\_

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1 to 39 are pending in the application.
- Of the above, claims 8 to 10 + 16 to 30 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1 to 7, 11 to 15 + 31 to 39 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other \_\_\_\_\_

Art Unit 126

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1 to 7, 11 to 15 and 31 to 39 are rejected under 35 U.S.C. § 103 as being unpatentable over Kitahara et al, British Patent (2) or Miyamoto et al. (3), cited in the parent application, No. 395,110, for the reasons of record. The composition claims, 32 to 34, are not considered patentable over the prior art any more than the compound claims since they recite the compound plus an inert carrier. The claims have been examined to the extent they read upon the elected species.

Claims 1 to 7, 11 to 15 to 31 to 39 are rejected under 35 U.S.C. § 103 as being unpatentable over Watsuka et al (4). Positional isomers of the instant compounds are taught on page 13, formula III of Watsuka et al. which renders the instant compounds and compositions prima facie obvious absent a showing

Serial No. 07/686,210

-3-

Art Unit 126

of unexpected properties. The claims have been examined to the extent they read upon the elected species.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



JAMES H. REAMER  
PRIMARY EXAMINER  
GROUP 120 - ART UNIT 126

Reamer:st  
October 21, 1991